

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of)
Werner Sobek et al) Art Unit: 3637
Appln. No. : 09/646,101) Ex: T.A.Phi Dieu N
Filed : September 21, 2000)
For : UMBRELLA DEVICE)

pmo
#22
2/12/04

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313 -1450

RECEIVED
FEB 10 2004
GROUP 3600

Sir:

Pursuant to the provisions of 37 CFR 1.192, submitted herewith is
Applicant/Appellant's Brief on Appeal.

REAL PARTY IN INTEREST

The real party in interest, that is the party that holds the entire right, title and
interest in this application is the assignee, Werner Sobek Ingenieure GmbH by assignment from
the inventors, recorded at Reel 011383 and Frame 0017 on December 12, 2000. The name of the
assignee was changed to Werner Sobek Ingenieure GmbH + Co. KG and this name change
recorded at Reel 013447 and Frame 0938 on November 1, 2002.

RELATED APPEALS AND INTERFERENCES

No appeal or interference is pending in any related application.

STATUS OF CLAIMS

In the Preliminary Amendment filed with the National Phase Application on

02/06/2004 HVUONG1 00000116 09646101

01 FC:2402

165.00 OP

September 21, 2000, claims 1 - 17 were canceled and replaced by claims 18- 35. Claims 25 - 35 were withdrawn from further consideration as non-elected claims, while claims 18 - 24 were examined. These claims were examined and reconsidered and finally rejected as follows:

Claims 18 - 21 as finally rejected under 35 USC 102(b) as anticipated Ennis (5,463,788);

Claim 22 as unpatentable under 35 USC 103(a) over Ennis (5,463,788) in view of Belanger (5,127,123);

Claim 23 as unpatentable under 35 USC 103(a) over Ennis (5,463,788); and

Claim 24 as unpatentable under 35 USC 103(a) over Ennis (5,463,788) in view of Fromme.

STATUS OF AMENDMENTS

Claims 18 - 24 were finally rejected on November 18, 2002. In reply the application was refiled as an RCE on May 19, 2003 along with a Response to the Final Rejection of November 18, 2002. In reply, the examiner issued a first action final rejection of claims 18 - 24 on June 5, 2003. A REQUEST FOR RECONSIDERATION without amendment was filed along with a NOTICE OF APPEAL on November 5, 2003. Claims 18 -24 as finally rejected on November 18, 2002 are the claims on appeal, which can be found in the Appendix hereto.

SUMMARY OF THE INVENTION

(the page and line references are to the specification)

The present invention relates to an umbrella device (page 1, lines 3 and 4). The umbrella device has an umbrella - like cap (11, 111, 211) which is rotatably maintained at the upper end of a shank (12, 112, 212) (page 4, lines 1 -3). In its closed state (Fig. 2) the cap droops down into a limp position of rest along the direction of the shank (page 4, line 5). In its

open state (Figs. 1A and 1B) the cap opens and assumes a stable umbrella-like operating position which is maintained by the centrifugal force resulting from the rotation of the cap (page 4, lines 6 - 8).

The cap (11, 111, 211) is positioned between disks (17 and 18) (page 4, lines 19 and 20) and rotated by a motor drive (15), which is fastened to the upper end of the shank (12) and connected to the lower disk (17) by a drive shaft (16) (page 4, lines 11 - 13). The two disks (17 and 18) form a fastening device (19) (page 4, lines 14 - 16). The opposite end of the shank (12) is fastened underneath a bottom surface (13) on a block (14) (Fig. 1B) (page 4, lines 10 - 11).

The umbrella-like cap (11, 111, 211) essentially consists of a membrane (21) made of a light material of low flexural strength, but having tensile strength (page 4, lines 17 - 18). The membrane has a circular base surface and is fastened around its center between the two disks (17 and 18) of the fastening device (19) (page 4, lines 17 - 19). To fold the membrane (21) into the position of rest or parked position in accordance with Fig. 2, the motor drive (15) is switched off or the speed of rotation is steadily reduced. (page 5, lines 13 - 16).

ISSUES

There are four (4) issues in this appeal which correspond to the rejections noted above: These are:

(1) Are claims 18 - 21 as finally rejected anticipated under 35 USC 102(b) by Ennis (5,463,788)?

(2) Is claim 22 unpatentable under 35 USC 103(a) over Ennis (5,463,788) in view of Belanger (5,127,123)?

(3) Is claim 23 unpatentable under 35 USC 103(a) over Ennis (5,463,788)? and

(4) Is claim 24 unpatentable under 35 USC 103(a) over Ennis (5,463,788) in view of Fromme (3,683,441)?

GROUPING OF THE CLAIMS

Claim 18 is defined in independent form, while claims 19 - 24 are in dependent form depending, ultimately from claim 18.

ARGUMENT

(1)

CLAIMS 18 -21 ARE NOT ANTICIPATED UNDER 35 USC 102(b) BY ENNIS BECAUSE THERE IS NOT ELEMENT BY ELEMENT COINCIDENCE WITH ENNIS

Anticipation under 35 USC 102 for an apparatus claim (Device) requires element by element coincidence. Each positively recited element must be found in a single reference, *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 18 defines the umbrella device to include three (3) positively recited elements: a shank, an umbrella-like cap and drive means. Ennis does not disclose an umbrella-like cap. Therefore, Ennis can not anticipate claim 18, nor claims 19- 21 because these claims depend from claim 18 and accordingly also include the same umbrella-like cap.

The rotary brushes 18 and 20 of Ennis are not umbrella-like caps no matter how they are viewed. The brushes 18 and 20 of Ennis do not have "tensile strength," they do not have "low flexural strength," and they do not have a "circular base surface." The brushes of Ennis instead are made of individual and separate components.

Also, the umbrella-like cap “comprises a membrane.” A membrane comprises a continuous structure. Surely, the individual and separate components comprising brushes 18 and 20 are not membranes as they do not comprise a continuous structure. The last thing a person skilled in the art would want is for a brush that is intended to wash a vehicle to be a continuous structure with sufficient tensile strength to maintain its continuity of structure.

It is especially noted that Ennis discloses a mechanized automated vehicle washing apparatus, and as such is not even remotely related to an umbrella. The examiner suggests that Ennis does disclose a membrane. He does not. If any dictionary is consulted, the examiner will find that a membrane is a sheet structure, which, by its very nature is continuous. The brushes of Ennis simply do not disclose such a structure.

Also, where in Ennis is there driving means “located at the end of said shank” as recited in claim 21? No such structure is found in Ennis.

(2)

CLAIM 22 IS NOT RENDERED UNPATENTABLE UNDER 35 USC 103(a)
OVER ENNIS IN VIEW OF BELANGER

A proper application of 35 USC 103 requires that a teaching basis exist for a proposed combination of references. See *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), and more recently, *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998).

Even if the combination has a basis, the invention claimed must result. Belanger does disclose subject matter which is analogous to that disclosed in Ennis, but neither disclose subject matter which is defined in claim 22. Claim 22, as noted above, depends from claim 18 and includes in its definition, the umbrella-like cap. We have already noted that Ennis alone

does not disclose such a cap. The combination with Belanger does not help. Belanger discloses brushes also not unlike those of Ennis. Together these references do not disclose an umbrella cap like that claimed in claim 18 or claim 22.

Moreover, there can be no conceivable reason for using the clamping structure of Belanger in the apparatus of Ennis. Why would the skilled person in the art familiar with the apparatus of Ennis use the clamping structure of Belanger? certainly not to form an umbrella because Ennis has nothing to do with umbrellas. Even a hindsight application of Ennis and Belanger based upon the present invention would make no sense because the two reference teach radically different structures.

(3)

CLAIM 23 IS NOT RENDERED UNPATENTABLE UNDER 35 USC 103(a)

OVER ENNIS

Claim 23 depends from claim 18 directly and therefore includes the recitation of the umbrella-like cap, which as noted above, cannot be derived from Ennis alone.

(4)

CLAIM 24 IS NOT RENDERED UNPATENTABLE UNDER 35 USC 103(a)

OVER ENNIS IN VIEW OF FROMME

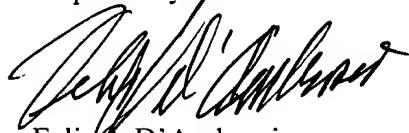
Claim 24 depends from claim 18 directly and therefore includes the recitation of the umbrella-like cap, which as noted above, cannot be derived from Ennis alone. Nor can it be derived from the combination of Ennis and Fromme. Fromme does not even disclose a circular element in the cleaning strips disclosed

SUMMARY

None of the references applied by the examiner have anything to do with an umbrella device. As such, these references relate to totally non-analogous art. See ***In re Deminski***, 230 USPQ 313 (Fed. Cir 1986). Deminski announced a two-step inquiry for testing analogous and non-analogous art: (1) Is the reference within the field of the inventor's endeavor? Here, emphatically no; and (2) If not, is the reference reasonably pertinent to the particular problem with which the inventor was involved? Here again, emphatically no

In view of the foregoing, the Board is urged to reverse the examiner and remand the application back to the examiner with directions to allow this application..

Respectfully submitted



Felix J. D'Ambrosio
Reg. No. 25,721

February 5, 2004

BACON & THOMAS
4th Floor
625 Slaters Lane
Alexandria, VA 22314 - 1176
(703) 683-0500

APPENDIX

(excluding non-elected claims)

18. An umbrella device, comprising:

a shank;

an umbrella-like cap connected to said shank, said umbrella-like cap comprising a membrane having tensile strength and low flexural strength, and circular base surface; and

driving means for driving said membrane, wherein said membrane defining a position of rest, wherein it droops limply around said shank, and an opened position, wherein it assumes an essentially horizontal position, said membrane assuming said opened position under the influence of centrifugal force generated due to the rotation of said membrane by said driving means.

19. The umbrella device in accordance with claim 18, wherein said driving means comprises an electric motor.

20. The umbrella device in accordance with claim 18, wherein said shank defines a head and said driving means is located at the head of said shank, and wherein said shank is fixed against relative rotation.

21. The umbrella device in accordance with claim 20, wherein said driving means comprises an electric motor.

22. The umbrella device in accordance with claim 18, further comprising:

means for clamping said membrane to said shank, said means for clamping

comprising two disks fixed against relative rotation with respect to said drive means.

23. The umbrella device in accordance with claim 18, wherein said driving means comprises a pneumatic drive.

24. The umbrella device in accordance with claim 18, wherein the energy supply for said driving means is received in said shank.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Re Application of

Werner Sobek et al

Appln. No. : 09/646.101

Filed : September 21, 2000

For: UMBRELLA DEVICE

)
)
) Art Unit: 3637
)
) Ex: T.A. Phi Dieu N
)
)
)
)

BRIEF ON APPEAL (3 COPIES)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

FEB 10 2004

GROUP 3000

Sir:

Transmitted herewith are three (3) copies of a Brief on Appeal in the above-identified application.

1. ☐ An Oral Hearing is requested.
2. ☐ An Oral Hearing is requested on _____.
3. ☐ An extension of time for filing the Brief on Appeal
 ☐ is hereby requested.
 ☐ was requested on _____.
4. ☒ A Verified Statement under 37 CFR 1.9 and 1.27
 ☐ is enclosed.
 ☒ is of record in this application.

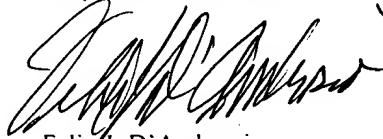
The fee is calculated as follows:

	Large Entity	Small Entity	Amount
Filing Brief on Appeal	\$330.00	\$165.00	\$165.00
Request for Oral Hearing	290.00	145.00	
Request for Extension of Time for Filing Brief			
<input type="checkbox"/> 1 month	110.00	55.00	
<input type="checkbox"/> 2 months	420.00	210.00	
<input type="checkbox"/> 3 months	950.00	475.00	
<input type="checkbox"/> 4 months	1,480.00	740.00	
<input type="checkbox"/> 5 months	2,010.00	1,005.00	

TOTAL DUE: \$165.00

5. () No fee required.
6. (X) A check in the amount of 165.00 is enclosed. (Check No. 38938)
7. () Please charge Deposit Account No. _____ in the amount of \$_____. A duplicate of this sheet is enclosed.
8. () The Commissioner is hereby authorized to charge payment of the following fees during the pendency of this application or credit any overpayment to Deposit Account No. 02-0200. A duplicate of this sheet is enclosed.
- () Any patent application processing fees under 37 CFR 1.17.
 - () The Issue Fee set in 37 CFR 1.18 at or before mailing of the Notice of Allowance, pursuant to 37 CFR 1.311(b).
 - () Any filing fees under 37 CFR 1.16 for presentation of extra claims.

Respectfully submitted.



Felix J. D'Ambrosio
Reg. No. 2,5721

February 5, 2004

BACON & THOMAS
4th Floor
625 Slaters Lane
Alexandria, VA 22314 - 1176

(703) 683-0500